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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,903	03/31/2000	CHRISTINE DUPUIS	05725.0532	7762

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EXAMINER	
MITCHELL, GREGORY W	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/485,903	DUPUIS ET AL.	
	Examiner	Art Unit	
	Gregory W. Mitchell	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 March 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-26,28-36 and 40-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-26,28-36 and 40-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office Action is in response to the Remarks filed March 17, 2005. Claims 18-26, 28-36 and 40-48 are pending and are examined herein.

It is noted that Examiner inadvertently listed claims 18-26, 28-32, 35, 36 and 40-48 as pending and as rejected in the Office Action dated October 20, 2004 when the claims should have been listed as 18-26, 28-36 and 40-48. All claim limitations of the inadvertently omitted claims were addressed in the previous Office Action, however.

35 USC § 103 Rejection Maintained

Claims 18-26, 28-36 and 40-48 stand rejected under 35 USC 103 as being obvious over Feder et al. (USPN 5721026) in view of both Dubief et al. (USPN 6024946) and Bolich (EP 0 240 349) for the reasons set forth in the Office Action dated October 20, 2004.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant argues, "Despite the Dubief and Bolich teachings, [the] new ground of rejection does not provide any motivation or suggestion as to the desirability of modifying the composition of Feder to include the recited amount of the at least one non-aminated silicone α,ω-disilanol, the propellant, and the weight of the propellant, as in the previous rejections." This argument is not persuasive. Feder et al. teaches that the α,ω-disilanol dispersions disclosed therein can be useful as cosmetic compositions for the treatment of hair, especially for achieving permanent waving (col. 11, lines 6-13).

As noted by Applicant, Feder et al. does not specifically teach the amount of α,ω-disilanol useful in the cosmetic compositions taught therein. Accordingly, it would have been obvious to one of ordinary skill in the art to look to the art to determine the amount of silicone known in the art to be useful in the treatment of hair. Dubief et al. is such a reference and teaches the use of silicone in the amounts as instantly claimed. Accordingly, it would have been obvious to the skilled artisan to utilize the α,ω-disilanol of Feder et al. in the amount as instantly claimed in a cosmetic composition for the treatment of hair. Furthermore, Feder et al. does not disclose the manner in which the cosmetic composition useful for the treatment of hair is to be dispensed. Accordingly, it would have been obvious to the skilled artisan to look to the art to determine the acceptable forms of delivery of cosmetic compositions suitable for hair treatment. Bolich is such a reference and teaches the use of the claimed propellants in mousses in the amount claimed. Accordingly, it would have been obvious to the skilled artisan to dispense the α,ω-disilanol cosmetic composition with a propellant in the amount claimed. It is further noted that it is well established that "where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant's argument that that the "'specific' motivation hardly amount[s] to the 'clear and particular' evidence required to provide the requisite suggestion or motivation to modify the cited reference teachings" is not persuasive. As noted above, Feder et al. does not specifically teach the amount of α,ω-disilanol to be utilized in the cosmetic compositions taught therein nor does Feder et al. specifically teach the mode of administration for the cosmetic compositions taught therein. Accordingly, the skilled artisan would have looked to the prior art to determine both the amount of silicone to utilize in the composition and the manner in which to dispense the composition.

Applicant argues, "The short passage identified in Feder, however, contains no guidelines as to obtaining the particular form of the claimed invention or how to achieve it." This argument is not persuasive for the reasons set forth above. Feder et al. teaches the use of α,ω-disilanol in cosmetic compositions for the treatment of hair, especially for achieving permanent waving, generally. Accordingly, it would have been obvious to the skilled artisan to look to the art to determine the specific concentrations of silicone useful and to determine the manner in which to dispense the composition. It is noted that it would have been obvious to one of ordinary skill in the art to modify the teachings of Feder et al. with those of Dubief et al. and Bolich because each of Feder et

al., Dubief et al. and Bolich are of an analogous art, namely, each is directed to aqueous hair cosmetics comprising silicones.

Applicant's argument that "Neither the Office nor Feder makes the assertion that the glass and concrete substrates in Example 1 and Table 1 are equivalents or analogous to keratinous material or skin for cosmetic use" is not persuasive. Examiner points out that while not specifically teaching the composition of Example 1 for hair cosmetic use, Feder et al. does state that "[t]he dispersions according to the invention can also be employed in cosmetology ..." Accordingly, Applicant's argument that glass and concrete are not taught to be analogous to keratinous material is not persuasive because such a teaching is unnecessary.

Applicant argues, "the Office provides no evidence to suggest that Feder is 'reasonably pertinent' to the problem identified in the presently claimed invention." This argument is not persuasive because the instant claims are directed to a "cosmetic composition" and Feder et al. teaches a "cosmetic composition".

Applicant's argument that "the dozen or so lines directed to cosmetic compositions amount to nothing more than an invitation to experiment, not to the 'clear and particular' evidence required to provide a suggestion or motivation to combine that thwarts a hindsight based rationale" is not persuasive. Feder et al. specifically points to cosmetic compositions for the treatment of hair. Furthermore, Feder et al. points to the cosmetic compositions comprising α,ω-disilanol taught therein for the specific purpose of producing permanent wave. It is Examiner's position that such a teaching is "clear and particular".

Double Patenting Rejection Maintained

Claims 18-26, 28-36 and 40-48 stand rejected under the judicially created doctrine of double patenting over U.S. Patent No. 6,165,446 ("'446") for the reasons set forth in the Office Action dated October 20, 2004.

Applicant argues that because '446 indicates "that 'other' types of radicals may include, for example, substituted or unsubstituted amino groups, amide groups, and quaternary groups" that '446 "teaches" away from the claimed invention. This argument is not persuasive because '446 claims the use of "silicone" generally and an α,ω-disilanol *is* a silicone. Furthermore, simply because '446 teaches that both aminated and non-aminated silicones are useful in the invention disclosed therein does not mean that '446 is "teaching away" from non-aminated silicones. '446 merely teaches that aminated and non-aminated silicones are both useful. The skilled artisan would have understood the "silicone" of '446 to mean both aminated and non-aminated silicones. Accordingly, one of ordinary skill in the art would have been motivated to utilize non-aminated silicones in the cosmetic composition of '446.

Applicant argues that "the Office fails to point to anything in the '446 specification for the selection of "non-aminated" silicones motivating the skilled artisan." This argument is not persuasive because, as discussed, above, the skilled artisan would have understood '446 to claim an invention encompassing non-aminated silicones. Accordingly, the skilled artisan would have been motivated to utilize non-aminated silicones in cosmetic compositions because such silicones are within the scope of the silicones taught by '446 to be useful in the invention claimed therein.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER